

REMARKS/ARGUMENTS

In view of the foregoing amendments and the following remarks, the applicants respectfully submit that the pending claims comply with 35 U.S.C. § 101, are not anticipated under 35 U.S.C. § 102 and are not rendered obvious under 35 U.S.C. § 103. Accordingly, it is believed that this application is in condition for allowance. If, however, the Examiner believes that there are any unresolved issues, or believes that some or all of the claims are not in condition for allowance, the applicants respectfully request that the Examiner contact the undersigned to schedule a telephone Examiner Interview before any further actions on the merits.

The applicants will now address each of the issues raised in the outstanding Office Action.

Rejections under 35 U.S.C. § 101

Claims 1-46 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Claim 1 has been amended to recite "a computer-implemented method" and to recite that each of the acts are performed with "a web-based email serving system including at least one computer." Furthermore, claim 1, as amended, recites storing, reading, and serving ad's). Thus, claim 1, as amended, is tied to a particular apparatus. Independent claim 43 has been

similarly amended. Independent claim 19, as amended, recites "a computer-implemented method" including acts performed with "a client device." Claim 19, as amended, further recites rendering various items by the client device. Independent claims 34, 40 and 45 have been similarly amended. These amendments are supported, for example, by paragraphs [0064]-[0068] of the present application. Thus, in view of the foregoing amendments and remarks, claims 1-46 are directed statutory subject matter under 35 U.S.C. § 101. The applicants respectfully request that the Examiner withdraw this ground of rejection.

Rejections under 35 U.S.C. § 102

Claims 1-23, 25-69 and 71-92 stand rejected under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent Application Publication No. 2003/0191689 ("the Bosarge publication"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

First, independent claims 1 and 47, as amended, are not anticipated by the Bosarge publication because the Bosarge publication does not teach accepting, with the web-based e-mail serving system, an ad request from **the client device**. In rejecting original claims 1 and 47, the Examiner cites paragraphs [0013]-[0018] of the Bosarge publication as teaching the features of original claims 1 and 47. (See Paper No. 20080913, page 3.) The applicants respectfully disagree.

In the **accepting** act of the claimed method, embodiments consistent with the claimed invention **accept**

an ad request from the client device. Requesting and serving an ad occur separately. This permits exemplary embodiments consistent with the claimed invention to "provide an asynchronous and opportunistically available solution that allows the user's e-mail to be rendered immediately, and then updated with appropriate advertisements if and when they became available." (See paragraph [0079] of the present application.)

By contrast, the Bosarge publication does not teach accepting ad request from a client device at all. The Bosarge publication states "electronic messages" are enhanced by "attaching a relevant, contextual advertising tag line or image/banner/words/HTML/Flash, etc. to the electronic message, and transmitting the enhanced message to a receiver." (Abstract of the Bosarge publication) Figure 2 of the Bosarge publication illustrates this directional process flow, wherein "email is sent directly to the OpenMX Mail Server... ads are pulled and appended ... to provide and transmit to the recipient an enhanced email." (Paragraph [0057] of the Bosarge publication) Since the ads are already appended to the electronic message, there is no need for the receiving device to request the ads. Even the "hyper linked word" disclosed in paragraph [0054] of the Bosarge publication would request ads after the enhanced message (along with the appended ads) has been rendered to the receiver. Therefore, Bosarge publication does not teach an act of accepting an ad request from the client device as claimed.

Thus, independent claims 1 and 47, as amended, are not anticipated by the Bosarge publication for at least the foregoing reasons. Since claims 2-18 directly or